Supreme Court, U.S.
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No. 1439

In the
Supreme Court of the United States
OCTOBER TERM, 1970

ETHICON, INC.,

Petitioner,

vs.

HANDGARDS, INC., ET AL.,

Respondents.

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI

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The Scheffer Press, Inc.—ANdover 3-6850

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ETHICON, INC. prays that this Court grant rehearing of its order of April 26, 1971, denying the petition for writ of certiorari, ... U.S. ....., and that a writ of certiorari issue to review the judgment of the Court of Appeals for the Ninth Circuit in the above-entitled case as prayed for in the petition filed March 5, 1971, herein.

REASONS FOR GRANTING REHEARING AND ISSUING THE WRIT

On May 3, 1971, after denying Ethicon's petition for certiorari, this Court announced its unanimous decision in *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation et al.*, ... U.S. ..... The decision provides additional reasons for granting Ethicon's petition.

1. In *Blonder-Tongue,* the Court held that a decision finding a patent invalid can, in certain circumstances, provide an estoppel in subsequent suits on the same patent against different defendants. The Court implicitly recognized, however, that the newly created estoppel requires an atmosphere of uniform federal law. Thus, the Court says the estoppel can apply only where the two suits involve the "identical question" (Slip Op. 20). The identical question requirement precludes estoppel where a conflict in law produces different legal questions in the first and second cases. Additionally, before the estoppel can be applied in the second suit, the Court must consider whether the patentee was prejudiced by not choosing his forum in the first suit (Slip Op. 19, 20), presumably because different forums may apply different legal standards.

Because the fundamental rule of law followed by the Ninth Circuit in public use cases is directly contrary to the rule followed in the other circuits, as fully discussed in the petition, the Ninth Circuit's decisions on public use will consequently have an estoppel effect limited to the Ninth Circuit. This obviously undesirable result can be prevented only by this Court resolving the conflict between circuits.

2. A court applying *Blonder-Tongue* to determine the estoppel effect of a prior decision of obviousness must ask "whether the first validity determination purported to employ the standards announced in *Graham* v. *John Deere Co.,* 383 U.S. 1 (1966)" (Slip Op. 20). Correlatively, in a public use case, under 35 U.S.C. § 102(b), the appropriate inquiry would be whether the first Court applied the standards of this Court's decision in *The Barbed Wire Patent,* 143 U.S. 275 (1892). As we have shown in the petition and reply, the Ninth Circuit does not apply the

standards of that case and its decisions, therefore, will not carry the estoppel effect which the supporting policies for *Blonder-Tongue* demand of all decisions in patent cases. Only this Court can remedy the situation by reviewing the unique standards applied in the Ninth Circuit.

CONCLUSION

For the reasons set forth above and in the petition for writ of certiorari, it is respectfully urged that rehearing be granted and that, upon such rehearing, a writ of certiorari issue to the Court of Appeals for the Ninth Circuit.

Respectfully submitted,

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CERTIFICATE OF COUNSEL

I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay and is restricted to grounds specified in Rule 58(2) of the rules of this Court.

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